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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,016	01/12/2001	Russell E. Parks	FIS9-2000-0282	1797

30743 7590 08/13/2003

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EXAMINER

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ART UNIT

PAPER NUMBER

3629

DATE MAILED: 08/13/2003

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 11

Application Number: 09/759,016

Filing Date: January 12, 2001

Appellant(s): PARKS ET AL.

MAILED

AUG 13 2003

GROUP 3600

C. Lamont Whitman
Reg. No. 22,424
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed June 4, 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences, which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1-4 (Group 1) and claims 5-7 (Group 2) do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

6,289,340 Puram et al. 9-2001

(10) *Grounds of Rejection*

Claim Rejections - 35 USC § 101 and 35 USC § 112

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

An invention, which is eligible for patenting under 35 U.S.C. § 101, is in the “useful arts” when it is a machine, manufacture, process or composition of

matter, which produces a concrete, tangible, and useful result. The fundamental test for patent eligibility is thus to determine whether the claimed invention produces a “useful, concrete and tangible result.” The test for practical application as applied by the examiner involves the determination of the following factors:

(a) “Useful” – The Supreme Court in *Diamond v. Diehr* requires that the examiner look at the claimed invention as a whole and compare any asserted utility with the claimed invention to determine whether the asserted utility is accomplished. Applying utility case law the examiner will note that:

- i. the utility need not be expressly recited in the claims, rather it may be inferred.
- ii. If the utility is not asserted in the written description, then it must be well established.

(b) “Tangible” – Applying *In re Warmerdan*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994), the examiner will determine whether there is simply a mathematical construct claimed, such as a disembodied data structure and method of making it. If so, the claim involves no more than a manipulation of an abstract idea and therefore, is nonstatutory under 35 U.S.C. § 101. In *Warmerdam* the abstract idea of a data structure became capable of producing a useful result when it was fixed in a tangible medium, which enabled its functionality to be realized.

(c) "Concrete" – Another consideration is whether the invention produces a "concrete" result. Usually, this question arises when a result cannot be assured. An appropriate rejection under 35 U.S.C. § 101 should be accompanied by a lack of enablement rejection, because the invention cannot operate as intended without undue experimentation.

Claims 1-7 are unpatentable under 35 U.S.C. 101 because the claimed invention lacks patentable utility. Specifically:

In Claims 1-7, the ambiguities cited would make it impossible for the process to be repeatable or "concrete." In other words, different users would come up with different responses.

As per Claims 1-7, it appears that the (Web-based, computer system running) Skills Matching Application (SMA) is attempting to sell a matching service for professionals, whereas a match is dependent on independent criteria provided (manual matching of prospects) by the "contracted" suppliers. Without any form of automation incorporated in this step of the process, there is no way to ensure concreteness or repeatability in the system. These independent criteria could contain a vast amount of different setting combinations – which would include different settings for each of the following: opinions of the supplier, pool of candidates available to the supplier, knowledge of skills and employer need by the supplier. Thus, this Skills Matching Application is not repeatable and would appear to be an attempt to patent an abstract idea not a "concrete" process.

Claims 1-7 also unpatentable under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention lacks a patentable utility, for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7 are unpatentable under 35 U.S.C. 102(e) as being anticipated by Puram et al. (US 6,289,340 B1).

As per independent Claims 1 and 4, Puram discloses a (Web-based) Skills Matching Application (SMA) which allows a user to communicate requirements to technical service suppliers in a way that significantly reduces the process time and improves the accuracy of requests sent to suppliers comprising the steps of: means for accessing the SMA from a Requisition/Catalog (REQ/CAT) application; means for prompting a user through a series of screens to enter a Statement of Work (SOW) and complete a skills detail checklist for each of the technical skills requested (Fig.2-185, C2 L44-50, C5 L60-65); means for

submitting the request to contracted suppliers by e-mail notification notifying the supplier that a new request has been entered into the SMA application for them to review and submit a candidate against (C2 L49-50, C2 L59-66, C3 L25-39); means for receiving from a supplier a candidate or candidates with appended resumes as appropriate; and means for displaying for the user the supplier responses and associated resumes (C8 L30-34).

As per independent Claim 5, (similar to independent Claims 1 and 4) Puram discloses a computer system running Skills Matching Application (SMA) which allows a user to communicate requirements to technical service suppliers in a way that significantly reduces the process time and improves the accuracy of requests sent to suppliers comprising the steps of: means for accessing the SMA from a Requisition/Catalog (REQ/CAT) application also running on the computer system; a display system for prompting a user through a series of screens to enter a Statement of Work (SOW) and complete a skills detail checklist for each of the technical skills requested (Fig.2-185, C2 L44-50, C5 L60-65); transmitting means for submitting the request to contracted suppliers by e-mail notification notifying the supplier that a new request has been entered in the SMA application for them to review and submit a candidate against (C2 L49-50, C2 L59-66, C3 L25-39); and receiving means for receiving from a supplier a candidate or candidates with appended resumes as appropriate, said display system displaying for the user the supplier responses and associated resumes (C8 L30-34).

As per Claims 2 and 6, Puram discloses wherein the SMA and REQ/CAT applications are Web-based and an SMA Web site is provided for suppliers to access to view request details and submit a candidate or candidates (Abstract, Figs.1b and 1c).

As per Claims 3 and 7, Puram discloses responding to a user's selection of a candidate or candidates by invoking an approval and procurement process (C7 L65-67, C9 L3-10).

(11) *Response to Argument*

Response to Declaration comments of Russell E. Parks

The appellant has made the declaration that the system has utility, due to the commercial success the claimed invention has proven since filed. The applicant also makes the declaration that "since different individuals have different skill sets and different requester have different skill need, one would expect different users to come up with different responses. Moreover, this should not be taken as an indication that the process is not repeatable or concrete."

As stated above in the 35 U.S.C. 101 rejection - an invention, which is eligible for patenting under 35 U.S.C. § 101, is in the "useful arts" when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. So while the declaration by Mr. Parks may prove the system has tangible and useful results, the system does not produce a concrete result, and therefore is unpatentable.

The system does include different skill sets and different requesters who have different skill needs, but, these are controlled through a template format and do not affect the repeatability of the system. The system further sends an email to a "contracted" supplier who looks at the SMA and manually matches an application to the skills template to the best of their ability. Without any form of automation incorporated in this step of the process, there is no way to ensure concreteness or repeatability in the system.

The appellant also makes the argument that the prior art of Puram et al. is simply a "Monster Board," and does not contain the functionality of Skills Matching Application described in the independent claims – to include:

- a. means for inputting skills requirements for a potential employee
- b. means for submitting the request to a contract supplier
- c. means for the contract supplier to manually matches resumes to the skills template entries.
- d. means for the supplier to send potential candidates to the requestor.

As described in the 102(e) rejection above, Puram discloses each and everyone one of these elements:

- e. means for inputting skills requirements for a potential employee (Fig.2-185, C2 L44-50, C5 L60-65)
- f. means for submitting the request to a contract supplier through e-mail, wherein the server would serve as the contract supplier and the electronic notification to the server (to notify the system that a request

for matching has been made) would serve as the "e-mail." (C2 L49-50, C2 L59-66, C3 L25-32)

- g. means for the contract supplier (server / computer system) to manually matches resumes (101 issue – prior art solves this 101 issues by automating the matching process) to the skills template entries. (C3 L25-39)
- h. means for the supplier (server / computer system) to send potential candidates to the requestor (C8 L30-34).

Response to Arguments made by Appellant's Attorney - C. Lamont Whitham

For Claim 1, the argument is made that the suppliers are "contracted" suppliers who are notified by e-mail. While Puram does not expressly use these terms, Puram does teach wherein the employer electronically submits (representing an electronic mail system) a skills matching request to a system / system administrator (who would represent a contracted supplier) through the system (C2 L49-50, C2 L59-66, C3 L25-32, C8 L41-46).

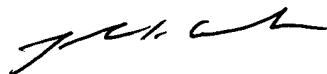
The argument is further made that the "contracted" suppliers are part of a proprietary system, which includes pre-negotiated rates for the services requested. This argument is mute because neither the language nor the concept is incorporated into the independent claims.

Finally, the argument is made that no database is maintained by the claim invention, and while this argument supports the above 101 rejection possibility

(lack of automation), the contracted supplier would inherently refer to a database or listing of possible candidates when trying to fill a requested employment slot. For Claim 5, the arguments are the same as those made for Claim 1; wherein, the suppliers are "contracted" suppliers who are notified by "e-mail." The response to the arguments stands as recited above, but to further clarify, the Claim language is covered by the prior art of Puram, although not through the same specific language. Puram describes system / system administrator (contracted supplier) which receives notification of a new skills matching request electronically (e-mail) (C2 L49-50, C2 L59-66, C3 L25-32) and electronically replies back to the employer with a viewable listing of matching candidates (C8 L30-34). Although Puram's system processes requests in a fraction of the time the proposed invention does, it still utilized the same claimed system components and follows the same claimed process.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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August 11, 2003

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Paper No: 12
Appeal No: 2004-0344
Appellant: PARKS, RUSSELL E.
Application: 09/759,016

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

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**Board of Patent Appeals and Interferences
Docketing Notice**

Application 09/759,016 was received from the Technology Center at the Board on November 3, 2003 and has been assigned Appeal No: 2004-0344.

A review of the file indicates that the following documents have been filed by appellant:

Appeal Brief filed on: June 4, 2003
Reply Brief filed on: None
Request for Hearing filed on: None

In all future communications regarding this appeal, please include both the application number and the appeal number.

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By order of the Board of Patent Appeals and Interferences